

## REMARKS

Careful consideration has been given to the Official Action of January 24, 2006 and reconsideration of the application as amended is respectfully requested.

Claims 1, 3-15 and 17-31 have been examined.

Claims 1, 3, 4, 11-15, 17 and 26-28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Blidung et al. (US Patent 5,630,309) in view of Draghetti et al. (US Publication 2003/0052020), Beck et al. (WO91/10595) and Feichtl et al. (US Patent 4,655,644).

Claims 5-7 and 18-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Blidung et al. (US Patent 5,630,309) in view of Draghetti et al. (US Publication 2003/0052020) Beck et al. (WO91/10595), Feichtl et al. (US Patent 4,655,644) and further in view of Montemayor et al. (US Patent 5,494,398).

Claim 29 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Blidung et al. (US Patent 5,630,309) in view of Draghetti et al. (US Publication 2003/0052020), Beck et al. (WO91/10595), Feichtl et al. (US Patent 4,655,644) and further in view of Focke et al. (US Patent 6,722,109).

Claims 8-10 and 21-25 are objected to, but would be allowable if rewritten in independent form.

Claims 30 and 31 are allowed.

### Discussion of Claims 1, 3-15 and 17-29

Claims 1 and 15 recite a method and a corresponding unit for handling and processing blanks for packing tobacco articles. The method comprises a relatively large number of steps (and the unit comprises a corresponding relatively large number of devices), which have been combined together for solving a specific technical problem, namely, avoiding the necessity of providing a packing machine with an on-line printing unit which poses various economic and functional problems. That is, known on-line printing units require that each production line be equipped with a respective printing unit, which, being located in series with the packing machine, may negatively affect operation and/or output of the machine, and also involves considerable extra cost. Moreover, if sophisticated enough to perform a large number of printing operations and/or operations other than and/or in addition to printing, the cost of on-line printing units of this type would be prohibitive.

As stated above, the claimed method comprises a relatively large number of steps (and the unit comprises a corresponding relatively large number of devices), each of which is per se

known. The essence of the present invention is to combine a number of steps (devices) in a new manner to solve the aforementioned technical problem. Such combination has never been shown or suggested prior to the present invention.

*"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."*  
MPEP § 2142

*"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."* MPEP § 2143.01

Blidung et al. discloses supplying stacks of blanks to a packing machine and the objective is to feed the stacks using two conveyors parallel to one another; Blidung et al. does not disclose or show the separation of individual blanks from a stack, since Blidung teaches only how to manage complete stacks of blanks. In other words, Blidung et al. discloses unloading groups (stacks) of blank from a pallet in a storage area and to form a succession of groups (stacks) of blank, which succession is fed from two conveyors parallel to one another.

Draghetti et al. discloses forming a succession of individual blanks from a reel of blanks, to process each blank individually, and then feeding each blank to a packing line.

Beck et al. discloses (embodiment of figure 1) to arrange stacks 4 of pre-printed pack blanks in a pack blank reservoir 2 in the form of a flat band conveyor 3, and to deliver single blanks 6 in series by means of a de-stacking device 5 to a printing unit 8 arranged downstream from a folding station 7 for printing individually each blank 6. According to a further embodiment shown in figure 2, the printing unit 8 is coupled to the pack blank reservoir 2 (located above the flat band conveyor 3). The printing unit inlet 12 is provided with a reservoir for stacked pre-printed blanks and the printing unit outlet 13 is modified to deliver stacked dried over-printed blanks to the conveyor belt 3 or to provide single blanks which can be manually or mechanically re-stacked on the conveyor belt 3.

Feichtl et al. discloses a machine tool, in which the workpieces to be machined are taken from pallets by a loader-unloader, which subsequently deposits the machined workpieces on

pallets. To simplify the handling of the pallets and to reduce nonproductive times, a pallet support is provided with a first stack station for supporting a stack of pallets carrying workpieces to be machined and with a second stack station for supporting a stack of pallets for receiving machined workpieces. The loader-unloader is operable to lift an empty pallet from the top of the first stack and to transfer said empty pallet to the second stack station.

Blidung et al., Draghetti et al. and Beck et al. fail to disclose or even suggest to moving an initially empty second pallet into the loading area of the storage area to receive the groups of processed blanks, and to feed the groups of processed blanks from the processing path onto the second pallet at the loading area of the storage area.

Feichtl et al does not relate to the packing art and also does not relate to the processing of blanks. Thus Feichtl et al is non-analogous art and there would be no suggestion to combine the teachings of Blidung et al., Draghetti et al. and Beck et al. with the teachings of Feichtl et al. in order to reach the present invention.

In the outstanding office action the Examiner states that *“It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the invention as taught by Blidung et al. to include moving a second empty pallet into a loading/unloading area as taught by Feichtl et al., since Feichtl et al. teaches that it is advantageous to simply handling of the pallets and reduce nonproductive times within the system.”*

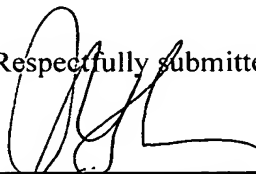
There is a limit to which the Examiner can combine references to meet a claim. In this case, the Examiner has combined four references (one of which is in non-analogous art) and extracts various features from these different references in an attempt to fashion a rejection on the grounds of obviousness under 35 USC 103 without regard to the non-obvious result arising from the claimed invention. It is respectfully submitted that the Examiner has exceeded the permissible basis for combining references under 35 USC 103, particularly where the references do not suggest the essence of the invention. In this respect the essence of the present invention is to load the new stacks of processed blanks onto a new empty pallet and to feed the new pallet loaded with the stacks of processed blanks to a packing machine for packing tobacco articles. Feichtl et al. discloses a loader-unloader for pallets, but it does not suggest that the new stacks of processed blanks can be loaded onto a new empty pallet and that the new pallet loaded with the stacks of processed blanks can be fed to a packing machine for packing tobacco articles.

Accordingly, claims 1 and 15 are deemed allowable over the cited references. Claims 3-14 and 17-29 depending from claims 1 and 15 respectively are therefore also deemed allowable.

## CONCLUSION

In view of the above action and comments, it is submitted that the claims as now present in this application are in good and proper form for allowance. Favorable action by the examiner is respectfully solicited. If, in the opinion of the examiner a telephone conference would expedite prosecution of the subject application, the examiner is invited to call the undersigned attorney.

Respectfully submitted,



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